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In re Application of
Langhans
Application No. 08/883,685
Filed: June 7, 1997
For: ROTARY CUTTING UNIT

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: Decision on Petition for
Patent Term Extension

The above-identified application has been forwarded to the undersigned for consideration on the petition entitled "Petition to the Director," which was filed on May 12, 2004, which is being treated as a petition for patent term extension under 37 CFR 1.181.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that the above identified application was filed on June 7, 1997, and was allowed on March 23, 2004. Petitioner argues that pursuant to 37 CFR 1.701(a)(3), the term of the patent should be extended for 1,183 days because issuance of the patent was delayed due to Appellate review by the Board of Patent Appeals and Interferences (Board). Petitioner argues that according to the Notice of Allowability the claims were determined to be allowable due to the decision by the Board. Petitioner states that the decision by the Board did not render the application allowable because the rejection of the claims under 35 U.S.C. § 112 based on the means plus function language in the claims was affirmed. Petitioner states that the § 112 rejection identified by the Board necessitated the filing of the RCE with an amendment to remove the language from the claims. Petitioner further argues that if the examiner had "identified" the "means-plus function language as the reason for the rejection of claims 1 and 18" under § 112, the objected to language could have been removed from the independent claims. Petitioner then argues that since the 102(b) rejection which prevented the allowance of Applicant's claims was overturned by the Board, and because the 112 rejection sustained by the Board could have been easily corrected without the appeal process, that Applicant is entitled to patent term extension pursuant to 37 CFR 1.701(a)(3).

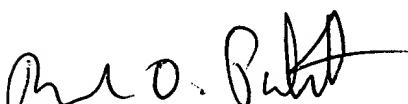
35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for patent term adjustment for administrative delays in applications filed on or after May 29, 2000. The statute provides that a patent issued pursuant to a decision in

the review (by the Board of Patent Appeals and Interferences) reversing an adverse determination of patentability is eligible for patent term extension. The statute also provides that a patent shall not be eligible for patent term extension if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

37CFR 1.701(a)(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. §§ 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.

While the above-identified application was filed after June 7, 1995, and was subject to an appeal before the Board, the claims were not allowed pursuant to a decision reversing an adverse decision of patentability. The examiner was affirmed in the decision by the Board mailed on November 6, 2003. To be eligible for patent term extension under 37 CFR 1.701(a)(3) all of the rejections of any one claim must ultimately be reversed.¹ Contrary to Petitioner's argument that the Examiner did not reject the claims with respect to the "means-plus function language" under 35 U.S.C. § 112, the examiner's rejection under 35 U.S.C. § 112 was affirmed by the Board. Furthermore, to be eligible for patent term extension, the statute requires that the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability and the examiner was affirmed. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Telephone inquiries with regard to this communication should be directed to the undersigned at (703) 308-8122.



Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt

¹See Comment 137 in Changes To Implement 20-Year Patent Term and Provisional Applications, 60 FR 79 (April 25, 1995).